



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,920	05/29/2001	Mathew Thankachan	SMQ-052 (P5699)	7547
959	7590	04/01/2005	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			BAYARD, DJENANE M	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/867,920

Applicant(s)

THANKACHAN, MATHEW

Examiner

Djenane M Bayard

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to amendment filed on 12/08/04 in which claims 1-24 are pending.

Response to Arguments

2. As per claims 1-10, Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Chernin fails to teach or suggest the step of creating a new document containing the data retrieved from the message. Applicant is interpreting the claims very narrow without considering the broad teaching of the references used in the rejection. It should be noted that the Examiner is entitled to the broadest reasonable interpretation of the claims. Furthermore, Chernin teaches wherein an "e-mail search display to be generated on the screen of the computer" and wherein "the e-mail search is completed the results are displayed ... and each item in the listing of the results is provided in the form of a Hypertext link". It is obvious that Chernin teaches that a new document comprised of Hypertext link is created (See col. 34 and col. 35, lines 1-20)

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of in view of U.S. Patent No. 6,643,694 to Chernin and further in view of U.S. Patent No. 6243501 to Jamali.

- a. As per claim 11, Special Edition Using Microsoft Outlook 2000 in view of Chernin teaches the claimed invention as described above. However, Special Edition Using Microsoft

Art Unit: 2141

Outlook 2000 in view of Chernin fails to teach wherein said new document is forwarded to a user after deleting the email data that is duplicative.

Jamali teaches wherein said new document is forwarded to a user after deleting the email data that is duplicative (See col. 2, lines 30-40).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said new document is forwarded to a user after deleting the email data that is duplicative as taught by Jamali in view of Special Edition Using Microsoft Outlook 2000 in view of Chernin in order to increase the amount of resources available for storing document (See col. 2, lines 30-40).

4. Claim 12-13, 15-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of in view of U.S. Patent No. 6,643,694 to Chernin and further in view of U.S. Patent No. 6,216,122 to Elson.

a. As per claims 12 and 18, Special Edition Using Microsoft Outlook 2000 teaches providing a storage locations for storing email messages, said email messages including a header and a body, said storage locations accessible by said email application (See page 3 and figure 18.7); providing a search feature for use with said email application, said search feature including a user-input parameter, said search feature using said parameter to reference data in said email messages (See page 1); However, Special Edition Using Microsoft Outlook 2000 fails to teach searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter;

Art Unit: 2141

inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document and plurality of storage location.

Chernin et al teaches “e-mail search display to be generated on the screen of the computer” and wherein “the e-mail search is completed the results are displayed ... and each item in the listing of the results is provided in the form of a Hypertext link” (See col. 34 and col. 35, lines 1-20)

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter; inserting the copied data from said selected email message and a hyperlink to said selected email message into a new document as taught by Chernin in the claimed invention of Special Edition Using Microsoft Outlook 2000 in order to display the results of a search operation initiated by a user (See col. 2, lines 42-50). However, Special Edition Using Microsoft Outlook 2000 in view of Chernin fails to teach a plurality of storage locations.

Elson et al teaches an electronic mail indexing folder having a search scope and interval. Furthermore, Elson et al teaches a plurality of storage locations (See 3, lines 27-44).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a plurality of storage locations in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Plow et al in order to provide continual access to the search result without having to specify the search each time the user wants to see the result (See col. 1, lines 55-58).

Art Unit: 2141

b. As per claims 13 and 19, Special Edition Using Microsoft Outlook 2000 teaches searching the header of said email messages for data referenced by said parameter; searching the body of said email messages for data referenced by said parameter; and searching any email attachments for data referenced by said parameter (See page 4).

c. As per claim 15, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is integrated with said email application (See page 1).

b. As per claim 16, Special Edition Using Microsoft Outlook 2000 teaches wherein said search feature is a stand-alone application (See page 2).

5. Claims 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of in view of U.S. Patent No. 6,643,694 to Chernin and further in view of U.S. Patent No. 6,216,122 to Elson as applied to claims 12 and 18 above, and further in view of U.S. Patent Application No. 2003/0131006 to Monahan et al.

a. As per claims 14 and 20, Special Edition Using Microsoft Outlook 2000 in view of Chernin and further in view of Elson teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 fails to teach wherein said new document is in Hypertext Markup Language (HTML) format.

Art Unit: 2141

Monahan teaches a method and system for communicating selected search results between first and second users over a network. Furthermore, Monahan teaches wherein the search result set page may be an HTML document (See page 4, paragraph [0054]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein the document is in Hypertext Markup Language (HTML) as taught by Monahan in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Chernin and further in view of Elson in order to communicate the search result to an HTML enabled e-mail client or browser that executes in a client machine (See page 4, paragraph [0054]).

6. Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,643,694 to Chernin and further in view of U.S. Patent No. 6,216,122 to Elson as applied to claims 12 and 21 above and further in view of U.S. Patent No. 6,243,501 to Jamali.

a. As per claim 17 and 21, Special Edition Using Microsoft Outlook 2000 in view of Plow et al and further in view of Elson et al teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 in view of Plow et al and further in view of Elson et al fail to teach wherein said new document is forwarded to a user after deleting the email data that is duplicative.

Jamali teaches wherein said new document is forwarded to a user after deleting the email data that is duplicative (See col. 2, lines 30-40).

Art Unit: 2141

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said new document is forwarded to a user after deleting the email data that is duplicative as taught by Jamali in view of Special Edition Using Microsoft Outlook 2000 in view of Chernin and further in view of Elson in order to increase the amount of resources available for storing document (See col. 2, lines 30-40).

7. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,216,122 to Elson and further in view of U.S. Patent Application No. 2002/0138474 to Lee.

a. As per claim 22, Special Edition Using Microsoft Outlook 2000 teaches providing a plurality of storage locations for storing email messages, said email messages including a header and a body, said storage locations accessible by said email application (See page 3 and figure 18.7); providing a search feature for use with said email application, said search feature including a user-input parameter, said search feature using said parameter to reference data in said email messages (See page 4); searching said storage locations with said search feature, said search feature copying less than all the data in a selected email message containing data referenced by said parameter inserting the copied data from said selected email message into a new document (See page 1); However, Special Edition Using Microsoft Outlook 2000 fails to teach a plurality of storage locations and caching a copy of said new document and cross-referencing said new document copy and said search request in an index of cached documents.

Elson et al teaches an electronic mail indexing folder having a search scope and interval.

Furthermore, Elson et al teaches a plurality of storage locations (See 3, lines 27-44).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a plurality of storage locations in the claimed invention of Special Edition Using Microsoft Outlook 2000 in order to provide continual access to the search result without having to specify the search each time the user wants to see the result (See col. 1, lines 55-58). However, Special Edition Using Microsoft Outlook 2000 in view of Elson fails to teach caching a copy of said new document and cross-referencing said new document copy and said search request in an index of cached documents.

Lee teaches wherein the search results, the underlying document listed in the search results, as well as the search criteria maybe saved in local or remote memory units (See page 3, paragraph [0025]).

It would have bee obvious to one with ordinary skill in the art at the time the invention was made to incorporate caching a copy of said new document and cross-referencing said new document copy and said search request in an index of cached documents as taught by Lee in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Elson in order to compile the search result for storage, display or other output (See page 2, paragraph [0020]).

b. As per claim 23, Special Edition Using Microsoft Outlook 2000 in view of Elson et al teaches the claimed invention as described above. However, Special Edition Using Outlook 2000 in view of Elson et al fails to teach searching said index for cached documents cross-referenced to a search request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a

Art Unit: 2141

last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request.

Lee teaches searching said index for cached documents cross-referenced to a search request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request (See page 3, paragraph [0024-0026]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate searching said index for cached documents cross-referenced to a search request; retrieving a cached document responsive to said search request; searching said storage locations for additional responsive data in email messages stored after a last modification date of said responsive cached document; updating said cached document with said responsive data so that only non-duplicative data is inserted into said cached document; and changing said modification date of said cached document to reflect the date of said search request as taught by Lee in the claimed invention of Special Edition Using Microsoft Outlook 2000 in view of Elson in order to compile the search result for storage, display or other output (See page 2, paragraph [0020]).

8. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Special Edition Using Microsoft Outlook 2000 by Gordon Padwick in view of U.S. Patent No. 6,216,122 to Elson and further in view of U.S. Patent Application No. 2002/0138474 to Lee as applied to claim 23 above, and further in view of U.S. Patent Application No. 2003/0002488 to Hyakutake.

a. As per claim 24, Special Edition Using Microsoft Outlook 2000 in view of Elson et al and further in view of Lee teaches the claimed invention as described above. However, Special Edition Using Microsoft Outlook 2000 in view of Elson et al failed to teach wherein said cached document is forwarded to a user.

Hyakutake teaches wherein said cached document is forwarded to a user (See page 8, paragraph [0153]).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein said cached document is forwarded to a user as taught by Hyakutake in the claimed invention of Special Edition using Microsoft Outlook 2000 in view of Elson et al and further in view of Lee in order to display the search result (See page 8, paragraph [0153]).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM..


Art Unit: 2141

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard

Patent Examiner


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER